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PATENT
APPLICATION 10/039,292
ATTORNEY DOCKET #2005P12932US (1009-235)

REMARKS

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 39, 46, 48, and 51 has been amended for at least one reason unrelated to patentability, including at least one of: to correct an informality; to explicitly present one or more limitations, phrases, words, terms, and/or elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 39-58 are now pending in this application. Each of claims 39, 46, and 51 are in independent form.

I. Consideration of Submitted References is Requested

On 8 April 2002, an Information Disclosure Statement and PTO Form 1449 listing and providing four references was submitted. On 7 October 2002, an Information Disclosure Statement and PTO Form 1449 listing and providing one reference was submitted. It is respectfully requested that those references be expressly considered during the prosecution of this application, that the references be made of record therein, and appear in the "References Cited" section of any patent to issue therefrom. It is respectfully requested that the next communication from the USPTO include a copy of the Form 1449 with the Examiner's initials beside each listed reference.

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II. The Obviousness Rejections

Each of claims 39-58 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of U.S. Patent No. 6,154,771 ("Rangan"), U.S. Patent Application Publication No. 2002/0059629 ("Markel"), U.S. Patent No. 6,637,032 ("Feinleib"), U.S. Patent No. 6,560,777 ("Blackketter"), and/or U.S. Patent No. 6,732,367 ("Ellis"). Each of these rejections is respectfully traversed.

A. Legal Standards

1. *Prima Facie* Criteria for an Obviousness Rejection

Over 40 years ago, in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham's* required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The United States Supreme Court clarified the obviousness inquiry criteria in *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). The KSR Court held:

1. "[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art";
2. "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art";
3. it is necessary "to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit"; and

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4. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

In order to establish a *prima facie* case of obviousness, certain criteria must be met. Evidence must be provided that indicates that the combination was obvious to a person with ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). There must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. In addition, the prior art reference (or references when combined) must teach... all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the “Patent Office has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). “It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis”. *Id.*

It is legal error to “substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results.” *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

“Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, ‘the burden of coming forward with evidence or argument shifts to the applicant.’” *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. Official Notice

Regarding Official Notice, MPEP § 2144.03.A states (emphasis added):

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[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of **instant and unquestionable demonstration as being well-known**. For example, assertions of... specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. *See also In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979).

Further, if an applicant traverses the examiner's assertion of official notice, the examiner **must provide documentary evidence** in the next Office Action if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2) and MPEP 2144.03C. *See also In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) ("[T]he Board cannot simply reach conclusions based on its own understanding or experience, or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.").

A bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible substitutes for evidence. *See In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). That is, deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.*

To the extent that Official Notice is explicitly or implicitly utilized to support any rejection, such as the rejection of any of claims 39-58, each such rejection is respectfully traversed and citation and provision of a reference that supports the rejection is respectfully requested.

3. Evidence of Obviousness – Combination of References

Under the *Graham* analysis, the "examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." MPEP 2142. The requirements for meeting this burden are clear.

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To factually support a *prima facie* conclusion of obviousness, an Office Action must provide evidence that indicates that the combination was obvious to a person with ordinary skill in the art. The evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007) (quoting *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

4. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office Action containing such rejection can not properly be made final. See, *In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

B. Analysis

1. Claim 39

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 39, from which each of claims 40-45 ultimately depends, states, *inter alia*, yet the applied portions of the relied upon references do not teach, “retrieving profile information related

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to a destination to which the received content is to be transmitted, the profile information updated responsive to previous user purchases, the profile information comprising user specified filtering criteria, the user specified filtering criteria adapted to cause an interactive program guide to be displayed with user-identified information filtered out” and “adding ATVEF information to the received content based on the retrieved profile information and the previous user purchases”.

c. Lack of Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action also fails to evidence the level of ordinary skill in the pertinent art. In addition, no evidence is presented that the present Office Action has considered objective evidence indicating obviousness or nonobviousness.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

d. Evidence of Obviousness – Combination of References

The present Office Action fails to provide evidence of obviousness as required under *KSR*.

Instead, regarding the proffered combinations of Rangan and Ellis, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 39, in such a manner so as to arrive at the claimed subject matter of claim 39. Regarding the proffered combination of Rangan and Ellis, the present Office Action states, at Page 6:

it would have been obvious to one of ordinary skill in the art to have combined the video-on-demand system of Rangan with the additional teachings of Ellis for the advantage of providing user defined filtering of content within the interactive program guide.

Instead, regarding the proffered combinations of Rangan, Ellis, and Markel, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 39, in such a

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manner so as to arrive at the claimed subject matter of claim 39. Regarding the proffered combination of Rangan, Ellis, and Markel, the present Office Action states, at Pages 6-7:

it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rangan and Ellis to include the claimed retrieving profile information for the user and modifying the video by adding ATVEF information to the video based on the retrieved profile information of the user for the benefit of providing hyperlinking triggers and data using a public standard which can be deployed to a variety of different devices.

Applicant respectfully submits that these unsupported assertions provide no evidence of, from the perspective of one of ordinary skill in the art, a “rational underpinning, to combine the known elements in the fashion claimed in the patent at issue”. Moreover, no evidence has been provided that this unsupported assertion was “known in the prior art”, as required by KSR. Applicant reiterates that under KSR “rejections on obviousness grounds cannot be sustained by mere conclusory statements”.

e. Conclusion

For at least these reasons, the present Office Action fails to establish a *prima facie* obviousness rejection. Accordingly, a reconsideration and withdrawal of the rejection of claim 39 is respectfully requested. Also a reconsideration and withdrawal of each rejection of each of claims 40-45, each ultimately depending from claim 39 is respectfully requested.

2. Claim 40

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. Instead, regarding the proffered combination of Rangan, Ellis, and Markel no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 40 in such a manner so as to arrive at the additional claimed subject matter of claim 40.

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For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 40. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 40.

3. Claim 41

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. Instead, regarding the proffered combination of Rangan, Ellis, and Markel no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 41 in such a manner so as to arrive at the additional claimed subject matter of claim 41.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 41. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 41.

4. Claim 42

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. Instead, regarding the proffered combination of Rangan, Ellis, and Markel no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 42 in such a manner so as to arrive at the additional claimed subject matter of claim 42.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 42. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 42.

5. Claim 43

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None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. Instead, regarding the proffered combination of Rangan, Ellis, and Markel no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 43 in such a manner so as to arrive at the additional claimed subject matter of claim 43.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 43. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 43.

6. Claim 44

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. Instead, regarding the proffered combination of Rangan, Ellis, and Markel no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 44 in such a manner so as to arrive at the additional claimed subject matter of claim 44.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 44. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 44.

7. Claim 45

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR.

Instead, regarding the proffered combinations of Rangan, Ellis, Feinleib, and Markel, no evidence is provided whatsoever regarding why one having ordinary skill in the art would

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combine the applied portions of the relied-upon references, that are used in rejecting claim 45, in such a manner so as to arrive at the claimed subject matter of claim 45. Regarding the proffered combination of Rangan, Ellis, and Markel, the present Office Action states, at Page 8:

it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Rangan, Ellis and Markel to include the claimed adding the ATVEF information based on the analysis of the closed caption information for the benefit of helping an author for determining points in which to add ATVEF information and to enhance a video program comprising closed captioning.

Applicant respectfully submits that these unsupported assertions provide no evidence of, from the perspective of one of ordinary skill in the art, a “rational underpinning, to combine the known elements in the fashion claimed in the patent at issue”. Moreover, no evidence has been provided that this unsupported assertion was “known in the prior art”, as required by KSR. Applicant reiterates that under KSR “rejections on obviousness grounds cannot be sustained by mere conclusory statements”.

For at least these reasons, the present Office Action fails to establish a *prima facie* obviousness rejection. Accordingly, a reconsideration and withdrawal of the rejection of claim 45 is respectfully requested.

8. Claim 46

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 46, from which each of claims 47-50 ultimately depends, states, *inter alia*, yet the applied portions of the relied upon references do not teach, “retrieving profile information related to a destination to which the received content is to be transmitted, the profile information updated responsive to previous user purchases” and “adding ATVEF information to the received content based on the retrieved profile information and the previous user purchases”.

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c. Lack of Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action also fails to evidence the level of ordinary skill in the pertinent art. In addition, no evidence is presented that the present Office Action has considered objective evidence indicating obviousness or nonobviousness.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

d. Evidence of Obviousness – Combination of References

The present Office Action fails to provide evidence of obviousness as required under *KSR*.

Instead, regarding the proffered combinations of Rangan and Ellis, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 46, in such a manner so as to arrive at the claimed subject matter of claim 46. Regarding the proffered combination of Rangan and Ellis, the present Office Action states, at Page 6:

it would have been obvious to one of ordinary skill in the art to have combined the video-on-demand system of Rangan with the additional teachings of Ellis for the advantage of providing user defined filtering of content within the interactive program guide.

Instead, regarding the proffered combinations of Rangan, Ellis, and Markel, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 46, in such a manner so as to arrive at the claimed subject matter of claim 46. Regarding the proffered combination of Rangan, Ellis, and Markel, the present Office Action states, at Pages 6-7:

it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rangan and Ellis to include the claimed retrieving

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profile information for the user and modifying the video by adding ATVEF information to the video based on the retrieved profile information of the user for the benefit of providing hyperlinking triggers and data using a public standard which can be deployed to a variety of different devices.

Applicant respectfully submits that these unsupported assertions provide no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence has been provided that this unsupported assertion was "known in the prior art", as required by KSR. Applicant reiterates that under KSR "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

e. Conclusion

For at least these reasons, the present Office Action fails to establish a *prima facie* obviousness rejection. Accordingly, a reconsideration and withdrawal of the rejection of claim 46 is respectfully requested. Also, a reconsideration and withdrawal of each rejection of each of claims 47-50, each ultimately depending upon claim 46, is respectfully requested.

9. Claim 47

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR.

Instead, regarding the proffered combinations of Rangan, Ellis, Blacketter, and Markel, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 47, in such a manner so as to arrive at the claimed subject matter of claim 47. Regarding the proffered combination of Rangan, Ellis, and Markel, the present Office Action states, at Page 9:

it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the enhancement data transmitted with the video in the combination of Rangan, Ellis and Markel, to include the claimed adding of

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ATVEF information includes modifying ATVEF information included in the received content and the claimed adding ATVEF information includes adding ATVEF to content that does not include ATVEF information as broadcast for the benefit of providing a user with updated and most recent ATVEF information.

Applicant respectfully submits that these unsupported assertions provide no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence has been provided that this unsupported assertion was "known in the prior art", as required by KSR. Applicant reiterates that under KSR "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

For at least these reasons, the present Office Action fails to establish a *prima facie* obviousness rejection. Accordingly, a reconsideration and withdrawal of the rejection of claim 47 is respectfully requested.

10. Claim 48

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR.

Instead, regarding the proffered combinations of Rangan, Ellis, Blackketter, and Markel, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 48, in such a manner so as to arrive at the claimed subject matter of claim 48. Regarding the proffered combination of Rangan, Ellis, and Markel, the present Office Action states, at Page 9:

it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the enhancement data transmitted with the video in the combination of Rangan, Ellis and Markel, to include the claimed adding of ATVEF information includes modifying ATVEF information included in the received content and the claimed adding ATVEF information includes adding ATVEF to content that does not include ATVEF information as broadcast for the

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benefit of providing a user with updated and most recent ATVEF information.

Applicant respectfully submits that these unsupported assertions provide no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

For at least these reasons, the present Office Action fails to establish a *prima facie* obviousness rejection. Accordingly, a reconsideration and withdrawal of the rejection of claim 48 is respectfully requested.

11. Claim 49

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*.

Instead, regarding the proffered combinations of Rangan, Ellis, Feinleib, and Markel, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 49, in such a manner so as to arrive at the claimed subject matter of claim 49. Regarding the proffered combination of Rangan, Ellis, and Markel, the present Office Action states, at Page 8:

it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Rangan, Ellis and Markel to include the claimed adding the ATVEF information based on the analysis of the closed caption information for the benefit of helping an author for determining points in which to add ATVEF information and to enhance a video program comprising closed captioning.

Applicant respectfully submits that these unsupported assertions provide no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence has been provided that this unsupported assertion was "known in the prior art", as required by *KSR*.

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Applicant reiterates that under *KSR* “rejections on obviousness grounds cannot be sustained by mere conclusory statements”.

For at least these reasons, the present Office Action fails to establish a *prima facie* obviousness rejection. Accordingly, a reconsideration and withdrawal of the rejection of claim 49 is respectfully requested.

12. Claim 50

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. Instead, regarding the proffered combination of Rangan, Ellis, and Markel no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 50 in such a manner so as to arrive at the additional claimed subject matter of claim 50.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 50. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 50.

13. Claim 51

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 51, from which each of claims 52-58 ultimately depends, states, *inter alia*, yet the applied portions of the relied upon references do not teach, “retrieving profile information for the user, the profile information updated responsive to previous user purchases” and “dynamically adding interactive content information to the video based upon the profile information and the previous user purchases”.

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c. Lack of Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action also fails to evidence the level of ordinary skill in the pertinent art. In addition, no evidence is presented that the present Office Action has considered objective evidence indicating obviousness or nonobviousness.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

d. Evidence of Obviousness – Combination of References

The present Office Action fails to provide evidence of obviousness as required under *KSR*.

Instead, regarding the proffered combinations of Rangan and Ellis, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 51, in such a manner so as to arrive at the claimed subject matter of claim 51. Regarding the proffered combination of Rangan and Ellis, the present Office Action states, at Page 4:

it would have been obvious to one of ordinary skill in the art to have combined the video-on-demand system of Rangan with the additional teachings of Ellis for the advantage of providing user defined filtering of content within the interactive program guide.

Applicant respectfully submits that these unsupported assertions provide no evidence of, from the perspective of one of ordinary skill in the art, a “rational underpinning, to combine the known elements in the fashion claimed in the patent at issue”. Moreover, no evidence has been provided that this unsupported assertion was “known in the prior art”, as required by *KSR*. Applicant reiterates that under *KSR* “rejections on obviousness grounds cannot be sustained by mere conclusory statements”.

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e. Conclusion

For at least these reasons, the present Office Action fails to establish a *prima facie* obviousness rejection. Accordingly, a reconsideration and withdrawal of the rejection of claim 51 is respectfully requested. Also, a reconsideration and withdrawal of each rejection of each of claims 52-58, each ultimately depending from claim 51, is respectfully requested.

14. Claim 52

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. Instead, regarding the proffered combination of Rangan, Ellis, and Markel no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 52 in such a manner so as to arrive at the additional claimed subject matter of claim 52.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 52. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 52.

15. Claim 53

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. Instead, regarding the proffered combination of Rangan, Ellis, and Markel no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 53 in such a manner so as to arrive at the additional claimed subject matter of claim 53.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 53. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 53.

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16. Claim 54

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. Instead, regarding the proffered combination of Rangan, Ellis, and Markel no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 54 in such a manner so as to arrive at the additional claimed subject matter of claim 54.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 54. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 54.

17. Claim 55

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. Instead, regarding the proffered combination of Rangan, Ellis, and Markel no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 55 in such a manner so as to arrive at the additional claimed subject matter of claim 55.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 55. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 55.

18. Claim 56

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. Instead, regarding the proffered combination of Rangan, Ellis, and Markel no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would

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combine the applied portions of the relied-upon references are used in rejecting claim 56 in such a manner so as to arrive at the additional claimed subject matter of claim 56.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 56. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 56.

19. Claim 57

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. Instead, regarding the proffered combination of Rangan, Ellis, and Markel no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 57 in such a manner so as to arrive at the additional claimed subject matter of claim 57.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 57. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 57.

20. Claim 58

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR.

Instead, regarding the proffered combinations of Rangan, Ellis, and Feinleib, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 58, in such a manner so as to arrive at the claimed subject matter of claim 58. Regarding the proffered combination of Rangan, Ellis, and Markel, the present Office Action states, at Page 10:

it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rangan and Ellis to include the claimed adding the

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ATVEF information based on the analysis of the closed caption information for the benefit of helping an author for determining points in which to add ATVEF information and to enhance a video program comprising closed captioning.

Applicant respectfully submits that these unsupported assertions provide no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence has been provided that this unsupported assertion was "known in the prior art", as required by KSR. Applicant reiterates that under KSR "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

For at least these reasons, the present Office Action fails to establish a *prima facie* obviousness rejection. Accordingly, a reconsideration and withdrawal of the rejection of claim 58 is respectfully requested.

III. The Finality of the Office Action is Improper, Premature, and Should be Withdrawn

Due to a failure to establish a *prima facie* rejection of any of claims 39-58, Applicant respectfully submits that the finality of the 4 April 2007 Office Action is premature. Thus, Applicant respectfully requests that the finality of the 4 April 2007 Office Action be withdrawn.

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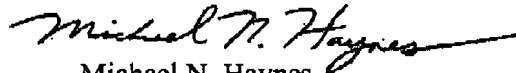
CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Examiner is invited to contact the undersigned at the telephone number listed below with any questions concerning this application.

Respectfully submitted,

Michael Haynes PLC



Date: 04 June 2007

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